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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210776
Party	Defendant Oak73, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AUDEMARS PIGUET HOLDING S.A.)	
)	
<i>Opposer,</i>)	
)	OPPOSITION NO. 91210776
v.)	
)	Serial No.: 85/776,034
OAK73, LLC)	Mark: OAK73
)	Filed: November 9, 2012
<i>Applicant.</i>)	
)	

**COMBINED ANSWER TO NOTICE OF OPPOSITION AND PARTIAL MOTION TO
DISMISS UNDER FED. R. CIV. PRO. 12(B)(6)**

OAK73, LLC (hereinafter referred to as “Applicant”), by and through its counsel, hereby answers the Notice of Opposition filed by AUDEMARS PIGUET HOLDINGS S.A. (hereinafter referred to as “Opposer”) as follows:

1. Applicant admits the allegations contained in paragraph 1.
2. Answering paragraph 2, Applicant admits that the records of the U.S. Patent & Trademark Office indicate that U.S. Reg. No. 965,112 for ROYAL OAK was issued on July 31, 1973, and that U.S. Reg. No. 2,885,834 for ROYAL OAK was issued on September 21, 2004. Applicant further admits that the filing dates for U.S. Reg. Nos. 965,112 and 2,885,834, as reflected in the records of the U.S. Patent & Trademark Office, predate Applicant’s November 9, 2012 filing date. Applicant lacks knowledge or information sufficient to affirm or deny the

current status, use, validity, or ownership of the pleaded registrations and therefore denies the same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3 and therefore denies the same.

4. Applicant admits that Ser. No. 85/776,034, for the mark OAK73 on “jewelry,” was filed on an intent-to-use basis and that the mark was not used in commerce on the goods stated in the application as of the filing date of November 9, 2012. Applicant is without knowledge or information sufficient to form a belief as to the ownership or validity of Opposer’s asserted trademark rights. Applicant also denies that any asserted priority in Opposer’s ROYAL OAK marks is relevant to any priority which may be claimed by the Applicant given the differences between the parties’ respective marks. Accordingly, Applicant denies that Opposer’s marks have any priority over Applicant’s mark.

5. Applicant denies the allegations contained in paragraph 5.

6. Applicant admits that the goods contained in the opposed application for the mark OAK73 are “jewelry.” Applicant further admits that the word “jewelry” is included in Opposer’s Reg. No. 2,885,834 for ROYAL OAK. However, the word “jewelry” appears in the description of goods in Reg. No. 2,885,834 following the wording “horological and chronometric instruments, namely, watch cases, watch bands...jewelry...” No semicolon or punctuation other than a comma separates jewelry from other items that are more obviously categorized as types of horological and chronometric instruments. The description of goods in Applicant’s registration is ambiguous as to whether it covers only jewelry in the form of “horological and chronometric instruments” or whether it includes “jewelry” more generally. Accordingly, Applicant denies

that its goods are identical to those for which Opposer has registered its marks. Applicant also denies the remaining allegations contained in paragraph 6, including the allegation that “jewelry” is similar to “the watches, etc. goods” in Opposer’s Reg. Nos. 965,112 and 2,885,834.

7. Applicant denies the allegations contained in paragraph 7. Moreover, for the reasons stated below, Applicant moves to dismiss Opposer’s petition under Fed. Rule. Civ. Pro. 12(b)(6) for failure to state a claim upon which relief can be granted to the extent it asserts dilution under Section 43(c) Lanham Act as a basis.

8. Applicant denies the allegations of paragraph 8.

MOTION TO DISMISS DILUTION AS A BASIS FOR OPPOSITION

Opposer relies on two bases for its opposition petition against Ser. No. 91/210,776: likelihood of confusion under Section 2(d) of the Lanham Act and trademark dilution under Section 43(c) of the Lanham Act. See Notice of Opposition at ¶¶ 5, 7. Applicant respectfully requests the dismissal with prejudice of the opposition filed by the Opposer to the extent it relies upon Section 43(c) because the Opposition fails to state a claim upon which relief may be granted under Rule 12(b)(6) of the Federal Rules of Civil Procedure.

“To prevail on its dilution claim, [plaintiff] must prove that its marks are famous and distinctive.” *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 670 (5th Cir. 2000) (citations omitted). A claim for dilution is meant to protect only the most famous of marks:

The examples of eligible “famous marks” given in the House Report - Dupont, Buick, and Kodak, see H.R. Rep. No. 104-374, at 3 (1995), reprinted in 1995 U.S.C.C.A.N. 1029, 1030 – are marks that for the major part of the century have been household words throughout the United States. They are representative of the best known marks in commerce.

TCPIP Holding Co. v. Haar Commc'ns., Inc., 244 F.3d 88, 93, 99 (2d Cir. 2001). *See also Board of Regents, Univ. of Texas Sy. ex rel. Univ. of Texas at Austin v. KST Elect., Ltd.*, 550 F. Supp. 2d 657, 674 (W.D. Tex. 2008) (“The legislative history speaks of protecting those marks that have an ‘aura’ and explains that the harm from dilution occurs ‘when the unauthorized use of a famous mark reduces the public’s perception that the mark signifies something unique, singular, or particular.’”). To remove any doubt that the level of fame required precluded protection for marks known in only limited markets (so-called “niche fame”), Congress amended the federal trademark dilution statute in 2006 to provide that “[f]or purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” 15 U.S.C. § 1125(c)(2)(A).

While the “Royal Oak” is historically famous as the tree in which Charles II of England hid to escape the Roundheads following the Battle of Worcester in 1651,¹ that renown is not transferrable to Opposer’s mark. By any definition, Opposer’s ROYAL OAK mark is not a household word, it is not among the “best known marks in commerce,” and it has no “aura” to it.

The allegations contained in the Petition are inadequate to establish the degree of fame required to sustain the opposition based on trademark dilution. Paragraph 7 states that “Opposer’s marks are famous and distinctive *in the relevant industry and trade*, and with consumers.” The Petition fails to include any allegation that its marks are “widely recognized by the general consuming public of the United States” as a designating Opposer’s goods. Nor does the Petition allege any facts indicating a plausible basis for Opposer to show fame as defined by the Lanham Act for dilution purposes. To the contrary, the single sentence in the Petition that

¹ http://en.wikipedia.org/wiki/Royal_Oak

relates to fame asserts that the mark enjoys only niche fame within a particular market, which is inadequate as a matter of law.

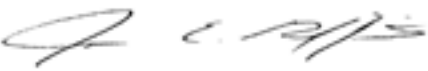
Because Opposer's own statement concerning the relative level of fame enjoyed by its marks makes clear that they do not rise to the level of recognition required under Section 43(c), Applicant respectfully requests dismissal of the Opposition with prejudice to the extent it relies upon trademark dilution as a basis.

WHEREFORE, Applicant prays that the opposition be dismissed with prejudice and/or that such opposition be denied.

Dated: June 14, 2013

Respectfully submitted,

FOLEY & LARDNER LLP

By:  _____

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing
COMBINED ANSWER TO NOTICE OF OPPOSITION AND PARTIAL MOTION TO
DISMISS UNDER FED. R. CIV. PRO. 12(B)(6) was forwarded by first class mail to:

John A. Galbreath
Galbreath Law Offices
2516 Chestnut Woods Ct.
Reisterstown, MD 21136-5523

attorney for Opposer, this 14th day of June, 2013.



James E. Griffith